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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte RAMANATHAN KASIVISWANATHAN,
SUDHEER SADANANDA KURKUNDHI, and
SRINIVASAN RAMASWAMY

_____

Appeal 2009-006278
Application 10/802,163
Technology Center 3600

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Decided: December 30, 2009

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Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-19 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

The Appellants' claimed invention is directed to method of handling a financial transaction in a transaction switch. Spec. [0004]. Claim 1, reproduced below, is representative of the subject matter of appeal.

> 1.   A method of handling a financial transaction in a transaction switch, the method comprising the steps of:
>
> receiving a primary transaction request from an initiator;
>
> identifying a host from a routing table for receiving the primary
>
> transaction request based on details provided in the primary transaction request;
>
> transmitting the primary transaction request to the identified host, receiving a response from the identified host, determining a need for transmitting the primary transaction request to another host; and
>
> interpreting the response received and transmitting a final outcome back to the initiator.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Ofir   US 7,219,149 B2   May 15, 2007

The following rejections are before us for review[1]:

1.   Claims 1-19 are rejected under 35 U.S.C. § 102(e) as anticipated by Ofir.

THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

This issue turns on whether the Appellants have shown that Ofir does not disclose the argued claim limitations for each respective claim as specifically argued.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:[2]

FF1. Ofir discloses a terminal adapter and network for transaction processing. Title.

_____

[1] We note that the Examiner has withdrawn the rejections of claims 1-19 made under 35 U.S.C. § 112, second paragraph, at page 7 of the Answer.
[2] *See Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2.   Ofir discloses a message is first sent to a Client Node 25a. The
Client Node then determines the appropriate Node to forward the
request to.   This decision is based on the host name selected by the
Terminal Adapter in a transaction protocol. The Client Node selects a
route to forward the transaction based on in part, the service name,
link capacity, configuration, and processing loading. Assuming the
message is forwarded directly to Service Node 25b, the Service Node
25b forwards the transaction to the Financial Transaction Processor 36
according to the protocol used to interconnect the Host 36 and Node
25b. (Col. 30:1-24).

FF3.   Ofir at Col. 30:1-20 does not specifically disclose determining
the need for transmitting the primary transaction request to another
host based on at least one of a payment type in a primary transaction
request.

FF4.   Ofir at Col. 20:46-66 and Fig. 10 discloses the switch from a
primary communication path to secondary communication path. Ofir
at Col. 20:46-66 does disclose first and second communication paths,
but does not specifically reference a secondary transaction containing
reference to a primary transaction and reversing the primary
transaction.

FF5.   Ofir in Fig. 12 A shows protocol types (VISA-I, VISA-II) and
transactions types and different destination hosts.

FF6.   Ofir discloses at Col. 29:64-65 that the Terminal Adaptor
selects an appropriate service name that identifies the Host processor
and transaction type.

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FF7. Ofir at Col. 16:60-67 discloses that the Terminal Adaptor determines the appropriate Host to relay the financial transaction information based on information provided by the Network 33.

FF8. Ofir has not specifically disclosed "identifying a transaction request as multi-host" and "means for identifying the transaction request as composite" at Col. 15:1-65, Col. 16:60-67, Col. 30:1-15 and Col. 29:55-65.

PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim.

ANALYSIS

Claims 1 and 18

The Appellants argue that the rejection of claims 1 and 18 is improper because Ofir fails to disclose "determining a need for transmitting the primary transaction request to another host". Br. 11, Reply Br. 2-3. The Appellants also argue that Ofir does not show the same request "transmitted to another host". Br. 12.

In contrast, the Examiner has determined that Ofir discloses the claimed limitations at Col. 30:5-20. Ans. 8.

We agree with the Examiner. Ofir discloses a terminal adapter and
network for transaction processing. FF1. At Col. 30:1-24 Ofir discloses,
that a message is first sent to a Client Node 25a. The Client Node then
determines the appropriate Node to forward the request to. The Client Node
selects a route to forward the transaction based on in part, the service name,
link capacity, configuration, and processing loading. Assuming the message
is forwarded directly to Service Node 25b, the Service Node 25b forwards
the transaction to the Financial Transaction Processor 36 according to the
protocol used to interconnect the Host 36 and Node 25b. FF2. Thus, the
Client Node determines which Node to forward the transaction request to
based in part, the service name, link capacity, configuration, and processing
loading meeting the cited claim limitation. The node to which the request is
forwarded may be broadly considered "another host" meeting the cited claim
limitation. For these reasons the rejection of claims 1 and 18 is sustained.
The Appellants have not argued separately for dependent claims 2-3 and the
rejection of these claims is sustained for these same reasons.

Claims 4, 9 and 17

The Appellants argue with regard to claim 4 that Ofir does not teach
"a secondary transaction containing a reference to the primary transaction"
and "transmitting a request reversing the primary transaction" and provides
similar arguments for claims 9 and 17. Br. 13-14 and 16.

In contrast, the Examiner has determined that Ofir discloses the cited
claimed limitations for claim 4 at Col. 20:50-67 and Fig. 10. Ans. 8-9.

We agree with the Appellants. Ofir at Col. 20:46-66 and Fig. 10 does
disclose first and second communication paths but does not specifically

reference a secondary transaction containing reference to a primary
transaction and reversing the primary transaction. FF4.

For these reasons the rejection of claims 4, 9, and 17 is reversed.

Claim 5, 12, and 19

The Appellants argue that the rejection of claim 5 is improper because
Ofir fails to disclose "a plurality of hosts and sending a plurality of packets
to the hosts based on the transaction and payment type". Br. 12-13, 16,
Reply Br. 3-5. In contrast, the Examiner has determined that Ofir discloses
the cited claimed limitations in Fig. 12A. Ans. 9-10. The Appellants
provides a similar argument for claim 12 and 19. Br. 12-13 and 15-16.

We agree with the Examiner. As noted above in reference to claim 1,
Ofir discloses that the Client Node then determines the appropriate Node to
forward the request to. FF2. The node to which the request is forwarded
may be broadly considered "another host" as well meeting the cited claim
limitation. Ofir discloses at Col. 29:64-65 that the Terminal Adaptor selects
an appropriate service name that identifies the Host processor and
transaction type. FF6. Ofir in Fig. 12A shows protocol types (VISA-I,
VISA-II which may be broadly considered "payment types") and
transactions types and different destination hosts. FF5. For these reasons
the rejection of claims 5, 12, and 19 is sustained. The Appellants have not
argued separately for dependent claims 6-8 and the rejection of these claims
is sustained for these same reasons.

Claims 10 and 13

The Appellants argue that the rejection of claims 10 and 13 is improper because Ofir fails to disclose "identifying a transaction as multi-host or composite". Br. 15.

In contrast, the Examiner has determined that Ofir discloses the cited claimed limitations because if the information provided to network 33 was multi-host, inherently this transaction would be relayed to the appropriate hosts. The Examiner cites to Ofir at Col. Col. 15:1-65, Col. 16:60-67, Col. 30:1-15 and Col. 29:55-65 as disclosing this feature. Ans. 5-6.

We agree with the Appellants. Ofir at Col. 16:60-67 discloses that the Terminal Adaptor determines the appropriate Host to relay the financial transaction information based on information provided by the Network 33. FF7. Ofir has not specifically disclosed "identifying a transaction request as multi-host" and "means for identifying the transaction request as composite at Col. 16:60-67. FF8.

> To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'

In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted). Here the mere fact that Ofir could identify a transaction as "multi-host" or "composite" is not sufficient to establish such structure beyond probabilities or possibilities. For these reasons the rejection of claims 10 and 13, as well as dependent claims 11 and 14-16, is not sustained.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 1-3, 5-8, 12, and 18-19 are rejected under 35 U.S.C. § 102(e) as anticipated by Ofir.

We conclude that Appellants have shown that the Examiner erred in rejecting claims 4, 9-11, and 13-17 are rejected under 35 U.S.C. § 102(e) as anticipated by Ofir.

DECISION

The Examiner's rejection of claims 1-3, 5-8, 12, and 18-19 is sustained. The Examiner's rejection of claims 4, 9-11, and 13-17 is reversed.

AFFIRMED-IN-PART

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